

Attorney Docket No: 23540-07445/US
Client Ref: 2001-072-2
USSN: 09/955,663

REMARKS

STATUS OF THE CLAIMS

Claims 1-14 were pending in this application. Claims 1, 13, and 14 have been canceled. Claims 2, 6, 7, and 8 have been amended. Following entry of the amendments claims 2-12 will be pending and at issue.

SUPPORT FOR AMENDMENTS TO THE SPECIFICATION

Reference number 10 on page 15 of the specification has been amended to correct the spelling of the first author's last name. The amendment merely corrects an informality, and entry is respectfully requested.

SUPPORT FOR AMENDMENTS TO THE CLAIMS

Claim 2 has been rewritten in independent form to incorporate all of the limitations of original claims 1 and 2. Claim 6, 7, and 8 have been amended to depend on now independent claim 2 instead of claim 1.

To further prosecution, Applicant has cancelled without prejudice claim 1 rendering the pending rejections moot. Applicant reserves the right to file subsequent applications claiming the canceled subject matter. In addition, the claim cancellation should not be construed as abandonment or agreement with the Examiner's position in the Office Action.

Pursuant to the restriction requirement made final and election of claims 1-12, Applicant cancels claims 13 and 14 with entry of this amendment. Applicant reserves the right to file subsequent applications claiming the canceled subject matter. In addition, the claim cancellations should not be construed as abandonment or agreement with the Examiner's position in the Office Action.

The amendments to the claims therefore add no new matter and entry is respectfully requested.

Attorney Docket No: 23540-07445/US
Client Ref: 2001-072-2
USSN: 09/955,643

OBJECTION TO THE SPECIFICATION

The Examiner objected to the disclosure "... because of the following informalities: Reference number 10 (page 15) wrongly cites "Rock, D.M." In response, Applicant has amended reference number 10 (page 15) to correct the spelling of the first author's last name. Withdrawal of this rejection is respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 1-12 were rejected under 35 U.S.C. 112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner stated that "Claim 1 recites the limitation "each model quantity" in the last line. There is insufficient antecedent basis for this limitation in the claim. The antecedent basis for said limitation is not clear because steps (a) to (g) do not recite any "model quantity" previous to the last line. Claims 2-12 are rejected for being dependent from claim 1."

Applicant has rewritten claim 2 in an independent form, incorporating all of the elements of claim 1 and excluding the language "model quantity" that had been added by amendment in the 06/16/04 Response. Claim 1 has been cancelled, and claims 3-12 ultimately depend on claim 2. These amendments render the pending rejection moot. Applicant reserves the right to file subsequent applications claiming the canceled subject matter. In addition, the claim amendments and cancellations should not be construed as abandonment or agreement with the Examiner's position in the Office Action.

Applicant believes that the pending claims as amended are not indefinite and respectfully requests withdrawal of this rejection.

REJECTIONS UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

Claims 1-12 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner stated that this was a new matter rejection, and that "The amendment to claim 1, last line, introduces new matter to the claims. Specifically, steps (b), (c), (e), and (g) are performed via

Attorney Docket No: 23540-07445/US
Client Ref: 2001-072-2
USSN: 09/955,663

estimating. The newly added limitation of "replaced by an estimate thereof" requires another step of estimating. The instant specification does not provide disclosure, as originally filed, for a method which requires the estimating to be performed with steps (b), (c), (e), and (g), and the estimating is repeated by the limitation of "replaced by an estimate thereof" in the last line of claim 1. Claims 2-12 are rejected for being dependent from claim 1."

Applicant has rewritten claim 2 in an independent form, incorporating all of the elements of claim 1 and excluding the language "replaced by an estimate thereof" that had been added by amendment in the 06/16/04 Response. Claim 1 has been cancelled, and claims 3-12 ultimately depend on claim 2. These amendments render the pending rejection moot. Applicant reserves the right to file subsequent applications claiming the canceled subject matter. In addition, the claim amendments and cancellations should not be construed as abandonment or agreement with the Examiner's position in the Office Action.

Applicant believes that the pending claims as amended are not drawn to new matter and respectfully requests withdrawal of this rejection.

REJECTIONS UNDER 35 U.S.C. § 103

Claims 1, 6-8, and 10 are rejected under 35 U.S.C. 103(a) as allegedly unpatentable over *Rocke et al.* (1995) taken with *Bailey et al.* (1987). Without agreeing with the Examiner's position, Applicant has cancelled claim 1 and amended claims 6-8 and 10 to ultimately depend on claim 2. These amendments render the pending rejection moot. Applicant reserves the right to file subsequent applications claiming the canceled subject matter. In addition, the claim amendments and cancellations should not be construed as abandonment or agreement with the Examiner's position in the Office Action.

Therefore, Applicant requests withdrawal of this rejection.

Attorney Docket No: 23540-07445/LIS
Client Ref: 2001-072-2
USSN: 09/955,663

CONCLUSION

Withdrawal of the pending rejections and reconsideration of the claims are respectfully requested, and a notice of allowance is earnestly solicited. If the Examiner has any questions concerning this Response, the Examiner is invited to telephone Applicant's representative at (415) 875-2316.

Respectfully submitted,
DAVID M. ROCKE ET AL.

Dated: 12/23/04

By: Susan T. Hubl

Susan T. Hubl, Ph.D. Patent Agent
Reg. No.: 47,668
Fenwick & West LLP
Silicon Valley Center
801 California Street
Mountain View, CA 94041
Tel.: (415) 875-2316
Fax.: (650) 938-5200